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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/790,775	03/03/2004	Ippei Nakamura	003510-149	3211

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EXAMINER

GILLIAM, BARBARA LEE

ART UNIT	PAPER NUMBER
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1752

DATE MAILED: 02/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/790,775

Applicant(s)

NAKAMURA, IPPEI

Examiner

Barbara L. Gilliam

Art Unit

1752

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 November 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 24-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 28 and 29 is/are allowed.
- 6) ☒ Claim(s) 24 and 25 is/are rejected.
- 7) ☒ Claim(s) 26 and 27 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 09/871,724.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. The amendment filed November 23, 2004 has been received and fully considered.
2. Claims 24-29 are pending. Claims 1-23 and 30 were canceled.
3. The rejection under 35 U.S.C. §112, 2nd paragraph of claims 26 and 29 is withdrawn in light of the amendment. The Examiner notes that although “Z² represents a polymethine chain of at least 5 carbon atoms” is not defined verbatim in the specification, no new matter has been added to the claims because of disclosure that “the infrared absorber may preferably have a polymethine chain of at least 5 carbon atoms” at page 4, lines 15-17 and page 7, lines 14-15. Applicant is encouraged to make the same amendment in the specification with respect to Z² and formulae (2) and (4).
4. The obviousness type double patenting rejection is withdrawn since this application is a divisional of parent application 09/871,724, in which a restriction requirement was made. 35 U.S.C. §121.
5. In light of the perfected priority, the rejection over EP 1 093 934 is withdrawn.
6. The indicated allowability of claim 25 is withdrawn in view of the newly discovered reference(s) to JP 2000-89341. Rejections based on the newly cited reference(s) follow.

Information Disclosure Statement

7. The Examiner does not have a copy of the cited European Search Report. If Applicant would like the European Search Report considered, he is encouraged to submit a copy.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 24 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 2000-289341.

a. The cyanine compound in paragraphs [0029] and [0033] each comprise fourteen fluorine atoms which meet the present limitations for an infrared absorber comprising a fluorine containing substituent which has at least 5 atoms. The cyanine compounds in paragraphs [0029] and [0033] also meet the structural requirements for the infrared absorber represented by general formula (1).

A full translation of JP 2000-289341 is underway.

10. Claim 24 is rejected under 35 U.S.C. 102(b) as being anticipated by Ukai et al. (US 4,555,481).

a. The benzimidazolocarbocyanine dyes represented by general formulae (I) and (II) (claim 1) each meet the present limitations for the infrared absorber comprising a fluorine-containing substituent which has at least 5 fluorine atoms when a is 3 to 6 (formula (I)) and m is 2 to 8 (formula (II)). For example, see compounds I-6. It is the Examiner's position, the cyanine dyes of Ukai et al. are inherently infrared absorbing because of the structural similarities to other infrared absorbing cyanine dyes. MPEP 2112.

Allowable Subject Matter

11. The indicated allowability of claim 25 is withdrawn in view of the newly discovered reference(s) to JP 2000-89341.

12. Claims 26 and 27 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

13. Claims 28-29 are allowed.

14. The following is a statement of reasons for the indication of allowable subject matter:

There is no teaching or suggestion in Ukai et al. (US 4,555,481) or JP 2000-289341 of infrared absorbing compounds meeting the structural requirements of present claims 26-29.

Response to Arguments

15. Applicant's arguments, see page 10, line 3 – page 11, line 12, filed November 23, 2004, with respect to the rejection(s) of claim(s) 24, 26-29 under 35 USC 102(b) and obviousness type double patenting have been fully considered and are persuasive. Therefore, the rejections have been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of JP 2000-289341 and US 4,555,481.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara L. Gilliam whose telephone number is 571-272-1330. The examiner can normally be reached on Monday through Thursday, 8:00 AM - 5:30 PM.

a. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

b. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Barbara L. Gilliam

Barbara L. Gilliam
Primary Examiner
Art Unit 1752

bg
February 7, 2005